

III. Remarks

A. Status of Application

Claims 1, 4, 5, 8-11, 13, 14 and 16-20 were previously pending.

Claims 1 and 14 have been amended.

Claims 4, 5, 8-11, 13 and 16-20 have been maintained in their previously-presented form.

As a result, claims 1, 4, 5, 8-11, 13, 14 and 16-20 are pending.

Favorable consideration of this application is respectfully requested.

B. Rejections Under 35 U.S.C. §103

1. Claims 1, 4, 5, 8, 9, 13, 14 and 16-20

Claims 1, 4, 5, 8, 9, 12-14 and 16-20 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,895,631 to Tajima ("Tajima '631") in view of in view of each of the following: Moore, Current Protocols in Pharmacology, 1998, A.3C.1-A.C3.7 ("Moore"); Gatlin et al., Anal. Biochem., 1998, 263: 93-101 ("Gatlin"); and Kussmann-Gerber et al., Analytical Biochemistry, 1999, 271: 102-105 ("Kussmann-Gerber"). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

Amended claim 1 recites the following:

A carrier housing/processing apparatus comprising;

at least one non magnetic carrier fixed or able to be fixed with chemical substances such as ligands;

a transferable carrier housing section comprising:

a large diameter section which accommodates said carrier, the large diameter section having a bottom, and

a small diameter section connected to the large diameter section, the small diameter section comprising a tip, and a fluid inlet/outlet at the tip;

a plurality of containers provided outside of said transferable carrier housing section;

a drawing/discharging section configured to draw a fluid through said inlet/outlet and into said transferable carrier housing section, and then discharge the fluid out of said transferable carrier housing section through said inlet/outlet; and

a transferring section which transfers said transferable carrier housing section relatively with respect to the containers, the transfer of said transferable

carrier housing section relatively with respect to the containers including the transfer of the large diameter section and the small diameter section relatively with respect to the containers, the transfer of the small diameter section relatively with respect to the containers including the transfer of the tip and the inlet/outlet relatively with respect to the containers,

wherein said carrier is formed in a size or a shape not allowing said carrier to pass through said inlet/outlet,

wherein said carrier is positioned at the bottom of the large diameter section,

wherein said carrier is configured to have a self-weight such that:

the position of said carrier is maintained at the bottom of the large diameter section by the self-weight while the drawing/discharging section draws the fluid in a first direction into the bottom of the large diameter section from the small diameter section, and

the position of said carrier is maintained at the bottom of the large diameter section by the self-weight while the drawing/discharging section discharges the fluid in a second direction into the small diameter section from the bottom of the large diameter section, the second direction being opposite to the first direction,

wherein said carrier housing section further comprises an opening having a size enabling said carrier to pass through, and said drawing/discharging section is provided with a nozzle which detachably connects with said opening, and said carrier is formed in a size capable of passing through said opening but not capable of passing through said inlet/outlet,

wherein the smaller diameter of the small diameter section of said transferable carrier housing section enables insertion of the smaller diameter section into each of the containers, the insertion of the smaller diameter section into each of the containers including the insertion of the tip and the inlet/outlet into each of the containers, and

wherein said carrier or said carrier housing section is provided with an adhesion prevention section for keeping said carrier from being adhered to the inner wall of said carrier housing section.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

In the present application, the Examiner has not met the burden of factually supporting a *prima facie* case of obviousness of amended claim 1 under 35 U.S.C. §103(a) for the reasons set forth below.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ...

(emphasis added).

Here, the cited combination of references fails to disclose the subject matter of amended claim 1. More particularly, Tajima '631, Moore, Gatlin and Kussmann-Gerber, alone or in any combination, do not disclose an apparatus wherein a carrier is configured to have a self-weight such that: the position of said carrier is maintained at a bottom of a large diameter section by the self-weight while a drawing/discharging section draws fluid in a first direction into the bottom of the large diameter section from a small diameter section, and the position of said carrier is maintained at the bottom of the large diameter section by the self-weight while the drawing/discharging section discharges the fluid in a second direction into the small diameter section from the bottom of the large diameter section, the second direction being opposite to the first direction.

Therefore, a rejection of amended claim 1 under 35 U.S.C. §103(a) cannot be supported by the combination of Tajima '631, Moore, Gatlin and Kussmann-Gerber. Thus, amended claim 1 is allowable.

Each of claims 4, 5, 8, 9, 13 and 19 depends upon and includes the subject matter of amended claim 1 and therefore is allowable for at least the same reasons as noted above with respect to amended claim 1.

Amended claim 14 is a method version of amended claim 1 and therefore is allowable for at least the same reasons as noted above with respect to amended claim 1.

Each of claims 16-18 and 20 depends upon and includes the subject matter of amended claim 14 and therefore is allowable for at least the same reasons as noted above with respect to amended claim 14.

In addition, it would not be obvious to modify the disclosures of Tajima '631, Moore, Gatlin and Kussmann-Gerber to include the subject matter of any of claims 1, 4, 5, 8, 9, 13, 14 and 16-20 because there is no reason to so modify the disclosures.

For all the foregoing reasons, it is respectfully requested that the rejection of claims 1, 4, 5, 8, 9, 13, 14 and 16-20 under 35 U.S.C. §103(a) over Tajima '631 in view of each of Moore, Gatlin and Kussmann-Gerber be withdrawn.

2. Claims 1, 4, 5, 8-11, 13, 14 and 16-20

Claims 1, 4, 5, 8-11, 13, 14 and 16-20 stand rejected under 35 U.S.C. §103(a) over Tajima '631 in view of each of Moore, Gatlin and Kussmann-Gerber, and further in view of U.S. Patent No. 5,919,706 to Tajima ("Tajima '706") and U.S. Patent No. 6,100,079 to Tajima ("Tajima '079").

The deficiencies of Tajima '631, Moore, Gatlin and Kussmann-Gerber with respect to claims 1, 4, 5, 8, 9, 13, 14 and 16-20 are noted above. Neither Tajima '706 nor Tajima '079 cures these deficiencies. Therefore, it is clear that the combination of Tajima '631, Moore, Gatlin, Kussmann-Gerber, Tajima '706 and Tajima '079 does not disclose the subject matter of claims 1, 4, 5, 8, 9, 13, 14 and 16-20, and of claims 10 and 11 which are dependent upon and include the subject matter of claim 1.

In addition, it would not be obvious to modify the disclosures of Tajima '631 Moore, Gatlin, Kussmann-Gerber, Tajima '706 and Tajima '079 to include the subject matter of any of claims 1, 4, 5, 8-11, 13, 14 and 16-20 because there is no reason to so modify the disclosures.

Accordingly, it is requested that the rejection of claims 1, 4, 5, 8-11, 13, 14 and 16-20 under 35 U.S.C. §103(a) over Tajima '631 in view of each of Moore, Gatlin and Kussmann-Gerber, and further in view of Tajima '706 and Tajima '079, be withdrawn.

D. Conclusion

It is believed that all matters set forth in the Office Action mailed September 14, 2010 have been addressed. Applicant has made a diligent effort to advance the prosecution of this application by amending claims 1 and 14 and submitting arguments in support of the patentability of claims 1, 4, 5, 8-11, 13, 14 and 16-20.

In view of all of the above, the allowance of claims 1, 4, 5, 8-11, 13, 14 and 16-20 is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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